

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of: B. Shankar <i>et al.</i> | : Examiner: Z. N. Davis |
| | : |
| For: Cannabinoid Receptor Ligands | : |
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| | : Confirmation No.: 5973 |
| | : |
| Serial No.: 10/803,577 | : Art Unit: 1625 |
| | : |
| Filing Date: 03/18/2004 | : |
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Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450
Mail Stop: Petitions

LETTER REGARDING PATENT TERM ADJUSTMENT DETERMINATION

Sir:

Authorization to charge the required \$200.00 fee (pursuant to Section 1.18(e)) to our Deposit Account No. **19-0365** is hereby given.

The patent term adjustment for this case indicated by the Office Action mailed 12/16/09 is 164 days. In making this determination, it appears that the PTO in calculating the total numbers of days of PTO delay may not have considered the period of 127 days in excess of three years of issuing the patent, which was 1/05/2010. A detailed review of the file history of this application reveals that the patent term adjustment should be 291 days and not 164 days. The basis for this correction is indicated below.

37 CFR §1.702(a)(1) and §1.703(a)(1) indicates that the PTO must mail the first office action within 14 months of the filing date of the subject application. In the present case, a restriction requirement was the first office action and it was mailed 05/06/2006, which is 351 days after the 14 month due date.

In addition, 37 CFR §§1.702(b) and 1.703(b) indicate that the PTO must issue a patent 3 years after the filing date of the subject application. The patent issued on 1/05/2010 resulting in a credit of 127 days.

Under 35 USC §132 the PTO must respond to a reply no later than 4 months after the reply was filed. After Applicants responded to restriction requirement on 5/22/2009, the PTO responded on 9/23/2009 resulting in a 1 day credit. Taking all the credits, the total is 479 days.

37 CFR §1.704(b) indicates that Applicants have three months to respond to a request and that failure to timely respond will result in a debit. In this case, a nonfinal response to an office action was filed after the three month deadline on 11/08/2006 for a debit of 91 days. In another case, a nonfinal response to an office action was filed after the three month deadline on 1/02/2008 for a debit of 33 days. Finally, a nonfinal response to an office action was filed after the three month deadline on 7/28/2008 for a debit of 63 days.

37 CFR §1.704(c)(8) indicates a debit for supplemental replies. A supplemental reply was filed on 02/05/2008 after an initial reply on 02/04/2008 responsive to a non-final office action for a debit of 1 day. The total for all debits is 188 days.

Considering the 188 day debit and the 479 day credit, the net credit is 291 days that the patent term should be extended.

This rule was analyzed under the PTO Exclusion Interpretation and not under 37 CFR §1.703(f) Actual Delay limitation.

On September 30, 2008, the District of Columbia District Court overturned the USPTO's interpretation of 35 USC 154(b)(2)(A) (the "Actual Delay" limitation, where to the extent that periods of delay overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed), in Wyeth et al. v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

In the present case, the PTO interpreted the delay of the first office action to overlap the number of days the issuance of the patent was delayed, thus only the delay based on the delayed issuance and the Applicant's delay was considered in the patent term adjustment. However, under Wyeth the total number of days should include the 351 day first office action delay, 127 day

In view of the foregoing, it is respectfully requested that this request for reconsideration of the patent term adjustment be considered and that the PTO send out a revised notice of Determination of Patent Term Adjustment and that the correct patent term adjustment be noted on the face of the patent.

If the Examiner has any further questions, the Examiner is invited to contact the undersigned.

January 20, 2009
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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kenrick L. Vidale', with a long horizontal flourish extending to the right.

Kenrick L. Vidale, Ph.D.
Reg. No. 65,281
Agent for Applicant